

REMARKS

Claims 1-10 are pending in the application. Reexamination and reconsideration and respectfully requested.

In the Office Action, the Examiner rejected claims 1, 2, 8 and 9 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 4,561,527 issued to NAKAMOTO et al. in view of admitted prior art disclosed in paragraph [0005] on page 2 of the instant application. As a matter of law, this rejection is improper and must be withdrawn. "Anticipation" under 35 U.S.C. §102 requires that all of the elements of a claim be found in a single reference. *In re Donohue*, 766 F.2d 531 (Fed. Cir. 1985) ("an anticipation rejection requires a showing that each limitation of the claim must be found in a single reference"). Accordingly, Applicants respectfully request that the rejection be withdrawn and the claims allowed.

In that regard, Applicants point out that even a combination of NAKAMOTO et al. in view of the "admitted prior art" does not read on Applicants' claimed invention. Applicants' independent claim 1 recites a system comprising both a motor vehicle startable without a mechanical key and an automatically activated parking brake system for such a motor vehicle. The automatically activated parking brake system includes an electronic control unit for automatically activating a parking brake in dependence on at least one specified operating parameter of the vehicle. Importantly, means for arbitrarily preventing the control unit from automatically activating the parking brake when the activation would otherwise occur based on the at least one specified operating parameter is also provided.

The Examiner references col. 6, lines 34-41 of NAKAMOTO for allegedly meeting the "means for arbitrarily preventing..." limitation. However, that passage refers to a controller provided with an "automatic control prohibition

circuit 37". That circuit does not "arbitrarily" prevent activation, but rather automatically does so upon the occurrence of certain events as specified in col. 6, lines 34-45. Hence, for this additional reason, even a combination of NAKAMOTO in view of Applicants' admitted prior art does not obviate Applicants' invention.

Finally, should the Examiner consider any obviousness rejection, Applicants respectfully submit it would be improper as being based on impermissible hindsight, for among other reasons. While Applicants agree that vehicles startable without mechanical keys are an advancement over vehicles that require mechanical keys, that fact alone does not suggest the combination discussed in the Office Action. Applicants' invention solves a problem wherein mechanical key vehicles automatically activate a parking brake at the latest upon removing the ignition key from the lock (see paragraph 3). To achieve the same functionality in a keyless system, various legal requirements have resulted in an automatically activated parking brake that activates the brake in dependence on at least one other operating parameter or operating state of the vehicle. Of course, this presents a problem which the present invention overcomes, that is, undesirable activation of the parking brake can sometimes occur. The present invention provides a means for arbitrarily preventing the automatic activation. NAKAMOTO, for that matter, neither recognizes the problem addressed by Applicants' invention nor does it attempt to solve it. Hence, any combination of NAKAMOTO with a keyless vehicle is merely the impermissible piecing together of Applicants' claim based on the teachings described in their specification. Such a hindsight rejection would be improper. As the court stated in W. L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983),

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious

effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.


In view of the above, Applicants submit claims 1-10 are in condition for allowance. An early notice to that effect is solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #951/50202).

Respectfully submitted,

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